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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,606	01/22/2001	Hiroshi Nojiri	202135US0	9738

22850 7590 03/24/2004

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EXAMINER	
WELLS, LAUREN Q	
ART UNIT	**PAPER NUMBER**
1617	

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/765,606	NOJIRI ET AL.	
	Examiner	Art Unit	
	Lauren Q Wells	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 November 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-6,12 and 15-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-6,12 and 15-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *9/12/01, 7/15/03,* 11/21/03
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1, 3-6, 12, 15-18 are pending. The Amendment filed 11/21/03, amended claims 1and 12, and added claims 15-18.

The Amendment to claim 12 is sufficient to overcome the 35 USC 112 rejection over this claim in the previous Office Action.

The Examiner notes Applicant's summary of the Interview on 10/28/03. It is respectfully pointed out that the summary by the Examiner states that the Applicant would consider providing comparative data. See the interview summary that was made of record on 10/28/03 and that was provided to the Applicant's representative that day.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3-4, 12, 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji et al. (JP 122424/1997) in view of Tada (JP 410036247).

The instant invention is directed toward a cosmetic composition comprising arginine and an alcohol selected from vetiverol, patchouli alcohol, guaiol, cedrol, and mixtures thereof.

Shoji et al. teach a cosmetic for improving rough skin, improving suppleness of skin, improving resiliency, improving face color, decreasing wrinkle formation, and decreasing spots and freckles. The composition comprising a copolymer, and amino acids or vegetable extracts, or combinations thereof. Arginine is taught as a preferred amino acid comprising 0.0001-15%

of the composition. The vegetable extracts are taught as comprising 0.0001-20% of the composition. The reference lacks a sesquiterpene alcohol. See pages 2-4, 6-9.

Tada et al. teach a composition comprising cedrol for preventing freckle formation. Cedrol is taught as comprising 0.01-10% of the composition. See abstract.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the composition of Shoji et al. and Tada et al. because it is obvious to combine two compositions taught by the prior art to be useful for the same purpose to form a third composition that is to be used for the very same purpose. In re Kerkoven, 205 USPQ 1069 (CCPA 1980). Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the two compositions because of the expectation of achieving a composition with enhanced effectiveness against freckle formation.

It is respectfully pointed out that while Tada et al. do not explicitly teach "in an amount effective for improving moisture loss of skin", Tada et al. do teach cedrol as comprising 0.01-10% of the composition, wherein this percent weight is "an amount effective for improving moisture loss of skin" of cedrol (component (B) of the instant invention). See for example instant claim 4, which recites component (B), cedrol, as comprising 0.01-20% of the composition.

Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji et al. in view of Tada et al. as applied to claims 1, 3-4, 12 and 15-18 above, and further in view of Herstein (5,616,332).

Shoji et al. and Tada et al. are applied as discussed above. The references do not teach pH.

Herstein teaches skin cosmetic compositions. The reference teaches that consumer use, over the counter preparations intended for daily or twice daily application should be relatively mild, with a pH of from about 4.5 to about 6.0. See Col. 7, lines 1-5.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the composition of the combined references as having a pH between 4.5 and 6 because of the expectation of achieving a composition that is over-the-counter and can be applied multiple times per day. Furthermore, it is respectfully pointed out that it is within the skill in the art to select optimal parameters in a composition in order to achieve a beneficial effect. In re Boesch, 205 USPQ 215 (CCPA 198). It would have been obvious for one skilled in the art to vary the proportions of components in a composition to arrive at the best compositions for the intended purpose. "It is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Only if the "results optimizing a variable" are "unexpectedly good" can a patent be obtained for the claimed critical range. In re Antonie, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977); see also In re Dillon, 919 F.2d 688, 692, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (in banc). Absent evident of unexpected results, the pH of the composition is not given patentable weight over the prior art.

Response to Arguments

Applicant argues, "there is no disclosure or suggestion in Tada to include cedrol in an amount effective for improving moisture loss of skin". This argument is not persuasive. Tada et al. teach cedrol as comprising 0.01-10% of a composition and the instant invention teaches "an amount effective for improving moisture loss" of cedrol as 0.01-20% of the composition. Thus,

while not explicitly stated, the combination of the references provides a composition of cedrol in "an amount effective for improving moisture loss".

Applicant argues, "Shoji describes many different compositions most of which lack the arginine component of the claimed cosmetic composition, and therefore the claimed composition is not suggested by the combination of Shoji and Tada". This argument is not persuasive. See page 7 of Shoji et al., which specifically states arginine as the preferred amino acid, and see the examples of Shoji et al., which specifically exemplify arginine as the amino acid.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is 571-272-0634. The examiner can normally be reached on M&R (5:30-4).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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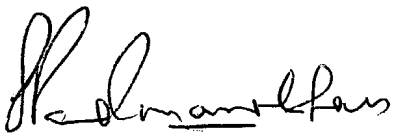

SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER